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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/599,290

03/25/2008

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EXAMINER

SCHMIDTMANN, BAHAR

ART UNIT

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4131

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,290	Applicant(s) CHO ET AL.	
	Examiner BAHAR SCHMIDTMANN	Art Unit 4131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 6-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09/25/2006; 07/01/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This application is a 371 of PCT/KR2004/001303, filed 1 June 2004.

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in the Republic of Korea on 26 March 2004. It is noted, however, that applicant has not filed a certified copy of the 10-2004-0020800 application as required by 35 U.S.C. 119(b).

Claims 1-10 are currently pending and are examined on the merits herein.

Information Disclosure Statement

It is noted that Foreign Patent Documents KR 2003-64986 and KR 2004-9983 have not been made available in the national stage file.

The listing of references in the Search Report is not considered to be an information disclosure statement (IDS) complying with 37 CFR 1.98. 37 CFR 1.98(a)(2) requires a legible copy of: (1) each foreign patent; (2) each publication or that portion which caused it to be listed; (3) for each cited pending U.S. application, the application specification including claims, and any drawing of the application, or that portion of the application which caused it to be listed including any claims directed to that portion, unless the cited pending U.S. application is stored in the Image File Wrapper (IFW) system; and (4) all other information, or that portion which caused it to be listed. In addition, each IDS must include a list of all patents, publications, applications, or other information submitted for consideration by the Office (see 37 CFR 1.98(a)(1) and (b)), and MPEP § 609.04(a), subsection I. states, "the list ... must be submitted on a

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separate paper." Therefore, the references cited in the Search Report have not been considered. Applicant is advised that the date of submission of any item of information or any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the IDS, including all "statement" requirements of 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Objections

Claims 6-7 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only, and/or cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, claims 6-7 have not been further treated on the merits.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

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not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-5 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. (*J. of Invest. Dermat.*, cited by Applicant in Information Disclosure Statement) and Ahn et al. (KR 10-2003-0075492, abstract, cited in PTO-892).

Lee et al. teaches the skin protective properties of ginsenoside F1, wherein ginsenoside F1 is suggested to protect cells against UVB induced apoptosis by maintaining constant levels of Brn-3a and inhibiting Bcl-2 down regulation (p.607, second column, second paragraph). Lee et al. teaches UVB causes said Bcl-2 down regulation via down regulation of said Brn-3a transcription factor in human HaCaT keratinocytes (p.607, second column, second paragraph). From these findings, Lee et al. teaches ginsenoside F1 as a compound useful in preventing UVB-induced skin damage (p.612, second column, final paragraph).

Lee et al. does not specifically teach a skin-care composition comprising (-) epigallocatechin-3-gallate, i.e. EGCG.

Ahn et al. teaches a cosmetic composition comprising epigallocatechin-3-gallate (EGCG) that inhibits aging of the skin. Ahn et al. suggests EGCG inhibits oxidation of the skin from oxygen and inhibits peroxide formation (abstract).

Ahn et al. does not specifically teach a skin-care composition comprising ginsenoside F1.

It should be noted that the recitation of "wherein said skin-care is obtained by the apoptosis-inhibitory effect of said active ingredients" in claim 2, and its dependent claims 3-5 are product-by-process claims and do not serve to further limit independent claim 2. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." See MPEP 2113.

It should be noted that the recitation of the preambles "an inhibitor of Rb protein dephosphorylation" in claim 8, the recitation of "an inhibitor of skin damage for preventing cellular damage caused by exposure to ultraviolet rays" in claim 9, and "an external composition for skin care" in claim 10 do not add patentable weight.

"It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." See MPEP 2144.06. Both Lee et al. and Ahn et al. teach a cosmetic composition for protecting the skin from external environmental agents, such as UV radiation or oxygen oxidation. Although the two compounds have not been taught in a single composition, it would have been obvious to a person of ordinary skill in the art to combine ginsenoside F1 and epigallocatechin-3-gallate in a cosmetic skin composition for protecting the skin.

One having ordinary skill would have been motivated to employ ginsenoside F1 and epigallocatechin-3-gallate in a skin-care composition because these active compounds have been shown to protect the skin from external environmental agents. Furthermore, one would have been motivated to combine both components because not only have they been proven useful on the skin, but the skin is normally exposed to both UV radiation and oxygen simultaneously. Thus, a composition comprising ginsenoside F1 and EGCG would have had expected success as active ingredients in a skin-care formulation.

Thus, the claimed invention as a whole is clearly *prima facie* obvious over the combined teachings of the prior art.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 8-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7-10 of copending Application No. 12/135,663 in view of Ahn et al. (KR 10-2003-0075492, abstract, cited in PTO-892).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application is drawn to a method of administering a composition comprising ginsenoside F1 to prevent skin-aging or skin cancer.

The claims of the instant application are drawn to a composition comprising ginsenoside F1 and EGCG for application to the skin. Ahn et al. teaches a cosmetic composition comprising epigallocatechin-3-gallate (EGCG) that inhibits aging of the skin.

A method of administering a composition comprising ginsenoside F1 necessitates the composition comprising ginsenoside F1. It is noted that the claims of the instant application also include (-)epigallocatechin-3-gallate. However, the transitional phrase of the copending application, "containing", does not exclude additional compounds.

Thus, the instant claims 1-5 and 8-10 are seen to be obviated by claims 7-10 of copending application no. 12/135,663.

This is a provisional obviousness-type double patenting rejection.

Claims 1-5 and 8-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6 of copending Application No. 10/586973 in view of Ahn et al. (KR 10-2003-0075492, abstract, cited in PTO-892).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application is drawn to a method for inhibiting biosynthesis of gelatinase comprising applying a composition comprising ginsenoside F1 and compound K.

The claims of the instant application are drawn to a composition comprising ginsenoside F1 for application to the skin. As discussed above, Ahn et al. teaches a cosmetic composition comprising epigallocatechin-3-gallate (EGCG) that inhibits aging of the skin.

A method of administering a composition comprising ginsenoside F1 necessitates the composition comprising ginsenoside F1. It is noted the claims of the copending application also includes compound K. However, the transitional phrase of the instant claim, "containing", does not exclude additional compounds. The transitional phrase of copending application, "containing", also does not exclude additional compounds.

Thus, the instant claims 1-5 and 8-10 are seen to be obviated by claim 6 of copending application no. 10/586973.

This is a provisional obviousness-type double patenting rejection.

Claims 1-5 and 8-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 12/064887 in view of Lee et al. (*J. of Invest. Dermat.*, cited by Applicant in Information Disclosure Statement).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application is drawn to an anti-aging composition comprising at least one of catechins and flavonols as an active ingredient. Claim 2 of copending application '887 lists (-)epigallocatechin gallate as one of the possible catechins used in the composition. As discussed above, Lee et al. teaches ginsenoside F1 as a compound useful in preventing UVB-induced skin damage.

The claims of the instant application are drawn to a composition comprising ginsenoside F1 and (-)epigallocatechin gallate for application to the skin.

An anti-aging composition comprising (-)epigallocatechin gallate necessitates the composition of instant application. It is noted the claims of the copending application also includes flavonols. However, the transitional phrase of the instant claim, "containing", does not exclude additional compounds. The transitional phrase of copending application, "containing", also does not exclude additional compounds.

Thus, the instant claims 1-5 and 8-10 are seen to be obviated by claim 1-2 of copending application no. 12/06488711.

This is a provisional obviousness-type double patenting rejection.

Claims 1-5 and 8-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-17 of copending Application No. 11/443271 in view of Ahn et al. (KR 10-2003-0075492, abstract, cited in PTO-892).

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application is drawn to a method of combating aging comprising topically applying a nanoemulsion that comprises a ginseng glucoside. Claim 16 of copending application '271 lists 20-O- β -D-glucopyranosyl-20(S)-protopanaxatriol (i.e. same as ginsenoside F1) as a ginseng glucoside.

The claims of the instant application are drawn to a composition comprising ginsenoside F1 and (-)epigallocatechin gallate for application to the skin. As discussed above, Ahn et al. teaches a cosmetic composition comprising epigallocatechin-3-gallate (EGCG) that inhibits aging of the skin.

A method of combating aging comprising topically applying a nanoemulsion that comprises a ginseng glucoside, necessitates the composition of instant application containing ginsenoside F1. It is noted that the claims of the instant application also include (-)epigallocatechin-3-gallate. However, the transitional phrase of the copending application, "containing", does not exclude additional compounds.

Thus, the instant claims 1-5 and 8-10 are seen to be obviated by claims 15-17 of copending application no. 12/06488711.

This is a provisional obviousness-type double patenting rejection.

Conclusion

No claim is found to be allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mrs. BAHAR SCHMIDTMANN whose telephone number is (571)270-1326. The examiner can normally be reached on Mon-Thurs 9:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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